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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Andrew E. Fano et al.

Serial No.: 09/520,943

Filing Date: March 8, 2000

Group Art Unit: 3623

Title: MAKING FINANCIAL DECISIONS
BY BALANCING GOALS IN A
FINANCIAL MANAGER

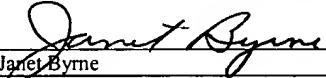
Examiner: Beth Van Doren

Docket No: 60021-352501

Mail Stop Appeal Brief - Patents
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Janet Byrne Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

Dear Sir:

Appellant filed an Appeal Brief dated August 8, 2005 supporting the appeal of the Office action made final dated January 13, 2005, in which Appellant argued its appeal of the rejections of Examiner Van Doren in the above referenced application. The Examiner filed an Examiner's Answer dated November 7, 2005, to which a Reply Brief was filed on December 30, 2005. The Appeal was first considered by the Board in July 2005, and the Appeal was returned based on an inconsistency between the Appeal and an Amendment After Final contemporaneously filed in August 2005. A telephonic interview was held between the Examiner and counsel for Appellant regarding the inconsistency, and clarification was noted. Subsequent to this conversation, the Examiner issued a new Examiner's Answer to the Appeal Brief on September 26, 2006.

Review of the Examiner’s Answer finds that the changes made clarify the original inconsistency in the status of the claims, but the argument and grounds of rejection presented by the Examiner stand unchanged. As such, Appellant hereby makes reference to its original Reply Brief filed December 30, 2005, the substance of which is duplicated below for ease of reference.

The remainder of this paper consists of the same content as initially filed December 30, 2005.

(1) ARGUMENT

Despite prosecution that has continued for a period of more than five years, Appellant and Examiner have been unable to resolve interpretive differences regarding the prior art reference *Jones, et al.*, U.S. Patent No. 6,021,297 (hereinafter “*Jones*”), the sole art reference that allegedly anticipates the claimed invention, as well as demonstrates that certain dependent claims are obvious when *Jones* is considered in light of what is old and well-known in the art. While *Jones* arguably discloses a financial planning tool to optimize a user’s investment portfolio allocation for retirement, what *Jones* fails to disclose is a modeling of tradeoffs between a plurality of disparate personal goals. Examiner’s propounded arguments fail in two regards. First, Examiner has applied incorrect standards and incorrect principles of claim interpretation when interpreting the claim language. Second, Examiner applies an incorrect gloss on *Jones*, contorting otherwise inapplicable art to reject Appellant’s propounded claims.

Briefly, *Jones* discloses a “Financial Advisory System” in which the system simulates the return of an investment portfolio to determine whether a *single* financial goal is attainable. *See Jones* at Abstract; 6:14-34. In doing so, a user enters personal information, including certain financial goals of the user and other user-defined assumptions, and the disclosed invention cycles the user through iterations to allow the user to select an appropriately optimized investment portfolio. *Id.* at 5:52-6:34. Apart from being able to project a retirement portfolio, the specification discloses the invention’s use for projecting attainment of other financial goals, such as purchase of a house or paying for a child’s college tuition. *Id.* at 4:24-34. Each of these goals are separately and individually projected.

Notably, however, despite the invention’s usefulness in projecting the attainment of a single financial goal, what *Jones* does *not* disclose is the simulation of attaining multiple goals

simultaneously. This is apparent not only from the plain language of *Jones*, in which several goals are subordinate to the goal projected, *see Jones* at 5:52-67; 6:3-6, but the mechanism of *Jones*, which does not account for modeling a plurality of goals. *See, e.g., Jones* at 13:44-18:49. This deficiency of *Jones* is the crux of this Appeal; Examiner asserts that *Jones* explicitly discloses the modeling of a plurality of goals. In so doing, Examiner fails to point to language in the *Jones* specification that explicitly discloses Appellant's claimed invention of the modeling and display of a plurality of goals *simultaneously*. The passages on which Examiner relies fail to provide support to Examiner's argument because, when considered in context, the passages of *Jones* only disclose an invention for optimizing a portfolio to obtain a single goal. Moreover, *Jones* does not account for the inclusion of non-financial goals in the process. With such shortcomings of *Jones* in mind, Examiner's arguments in opposition to Appellant's can be dispatched in short order; those arguments are discussed *seriatim*.

A. Rejections Pursuant to 35 U.S.C. § 102(e).

Apparent from the disclosure of *Jones* is that it fails to disclose the consideration and projection of a plurality of goals at the same level. Instead, in *Jones* a plurality of goals are considered as a subset to projecting attainment of a specific financial goal, be that retirement, purchasing a house, or some other interim financial goal. *Jones*, at 5:50-67. What *Jones* fails to do is project attainment of multiple goals simultaneously. Moreover, *Jones* fails to account for non-financial goals, and fails to anticipate preference criteria adjustment.

Simultaneous Modeling and Display. Examiner argues that *Jones* discloses simultaneous modeling through application of an inappropriate gloss on *Jones*. Contrary to Examiner's description and interpretation, *Jones* does not disclose the simultaneous modeling of multiple goals in which the impact of each on the other is displayed. *Jones* discloses a tool that permits the entry of short, intermediate, or long-term goals subordinate but affecting modeling of the financial portfolio for retirement or some other financial goal. *See Jones* at 5:52-67. If a user would want to model attainment of a different goal than retirement, for example, purchasing a vacation home, the user would have to conduct another iteration of optimization designating retirement as a subordinate long-term goal to obtain an optimized portfolio for purchasing a vacation home. The optimization would not reflect the previously performed optimization for retirement. In contrast, the present invention provides simultaneous modeling of both goals such that the optimized projected attainment of both is achieved *at the same time*. *See Claim 21(g)*.

Hence, because *Jones* does not discuss simultaneous modeling, *Jones* fails to anticipate the claimed invention. Regarding Examiner’s claim of a graphical user interface presented in *Jones*, while graphical projection may be provided for the projected optimized portfolio, it fails to disclose a graphical projection of a plurality of goals.

Non-Financial Goals. Examiner asserts that it is incomprehensible that a non-financial goal is contemplated by the claimed invention, supporting this argument with language otherwise inappropriate for consideration. Examiner fails to interpret the plain language of the claim. As mandated by the Manual of Patent Examining Procedure, “the claims must be interpreted as broadly as their terms reasonably allow.” MPEP § 2111.01 (citing *In re American Academy of Science Tech. Center*, 367 F.3d 1359, 1369, 70 U.S.P.Q.2d 1827, 1834 (Fed. Cir. 2004)). As further explained, “especially in non-chemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification.” *Id.* (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906, 69 U.S.P.Q.2d 1801, 1807 (Fed. Cir. 2004)). Here, Examiner interprets claim 21(b) by limiting the language of a “plurality of goals” to only include “financial goals.” However, claim 21(b)’s plain language does not disclose a plurality of “financial goals”; “goals” as used in the claims are not defined in the specification. Appellant has declined to do so. *See* MPEP § 2111.01 (entitling Applicant to be own lexicographer). While the “goals” disclosed in claim 21(b) are “related to cash flow,” such relation does not make “goals” *per se* “financial goals,” as argued by the Examiner. Indeed goals could be non-financial in nature but still relate to the cash flow of the user; two examples would be starting a family or establishing a new hobby.

Additionally, Examiner’s reference to the title as support for the conclusion that the appropriate interpretation of “goals” is “financial goals” is patently wrong for the same reason – the specification cannot limit the claims during prosecution.¹ Likewise, reliance on a dependent claim to interpret an independent claim from which it depends is wholly inappropriate because of the fundamental difference between a dependent versus independent claim; by necessity and principle the dependent claim is limiting and narrower than the independent claim, it cannot limit the independent claim.

¹ While the title may not be reflective of the present claims, it is Appellant’s practice to amend the title after allowance and prior to payment of the issue fee to minimize prosecution expense.

Moreover, Examiner’s failure to understand how goals could be either non-financial and financially related is irrelevant because Examiner’s level of skill and understanding is not the appropriate standard; the standard applicable is the understanding of the hypothetical person of ordinary skill in the art. *See* MPEP § 2111.01. Such a hypothetical person would understand the distinction between financial and non-financial goals.

Finally, Examiner fails to rebut the argument that non-financial goals are not disclosed by *Jones* through citation to *Jones*. Examiner relies upon examples provided in *Jones* of financial goals – purchasing a home, sending a child to college, money saving and money investing plans, or purchasing a car. *Jones* at 4:27-33. Examiner claims several of these examples, purchasing a home or car, for example, are *not* financially related, but have financial implications. (*See* Answer at 25). Obviously, these goals have financial implications because they are financial goals; each has a direct financial impact or financial consequence on the user. Not addressed, however, are goals without a clear financial element – developing a hobby, for example. Based on the language of the claim, which does not qualify “goals”, such language should be read to include non-financial goals. *See* MPEP § 2111.01.

Preference Criteria Adjustment. Similarly, an inappropriate gloss is applied to *Jones* regarding *Jones*’ disclosure of preference adjustment for individual goals. Specifically, Examiner claims that *Jones* permits a user to select multiple goals, and then presents to the user preferences for each goal for the user to adjust. (Answer at 26). While facially attractive, consideration of *Jones* finds that the elements described by the Examiner do not exist in the order presented in the claim. “A claim is anticipated only if each and every element is found … in a single prior art reference.” MPEP § 2131 (quotation removed). Further, “[t]he identical invention must be shown in compete detail as is contained in the … claim.” *Id.* (quoting *Richardson v. Suzuki Motor Corp.*, 868 F2d 1226, 1236, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). “The elements must be arranged as required by the claim.” *Id.* (citing *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). Here, although *Jones* arguably discloses the entry of different types of goals as part of establishing a user profile, see *Jones* at 5:52-67, *Jones* fails to disclose establishing a preference between goals in a similar category. The invention as claimed does not distinguish between goals of different types, be they short, intermediate, or long-term, as does *Jones*. *See id.* Instead, the invention claims an ability to adjust a user’s favoritism between

two defined goals, although the time for achieving each goal could be of the same temporal length.

Additionally, Examiner's claim that *Jones* discloses the provision and adjustment of preferences is unsupported by the *Jones* disclosure. While it is not necessary for an anticipatory reference to use the exact same terminology, *see* MPEP § 2131, the elements must still be presented in the same order as presented in the claim. *Id.* An adjustment of preferences is not defined in *Jones* as it is in the claimed invention. Examiner asserts that *Jones* presents such preferences as "save more money, retire later, take on additional investment risk," however such language appearing in *Jones* is in the context of instructions provided to a user after producing a portfolio optimization iteration. *See Jones* at 6:13-27. Such language is not related to preference adjustment *as claimed*. Consequently, *Jones* fails to anticipate the claimed invention.

B. Obviousness Rejections Pursuant to 35 U.S.C. § 103(a).

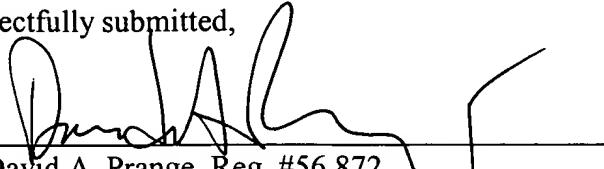
Regarding claims 28-39, 41-45, 47-49, 57-61, 63-68, 70-74, 76-78, 86-90, 99-103, and 105-107, Examiner concedes the allowability of such claims if independent claims 21, 50, and 79 are found allowable. Examiner does not contest that the rejections are based on the assumption that the independent claims are anticipated by *Jones*. Hence, should the Board find that *Jones* fails to anticipate Appellant's propounded claims, resulting in such claims being allowed, such claims rejected on the basis of obviousness should be likewise allowed.

(2) CONCLUSION

Pending claims 21-27, 50-56, and 79-85 remain rejected pursuant to 35 U.S.C. § 102(e). Pending claims 28-39, 41-45, 47-49, 57-61, 63-68, 70-74, 76-78, 86-90, 99-103, and 105-107 remain rejected pursuant to 35 U.S.C. § 103(a). Appellant respectfully disagree with the Examiner on this matter and request that the Board of Patent Appeals and Interferences reverse the Examiner's decision.

Should any additional fees be necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference #60021-352501).

Respectfully submitted,

By 

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